

REMARKS:

This amendment is for the purpose of amending the Specification in the original application by canceling claims 9 and 10, amending claims 1, 15 - 20 and 28 so that claims 1 - 3, 8 and 15 - 28 remain in this application.

In the Official Action claim 28 is objected to as containing informalities, specifically in line 3 the claim contains "...damage, edging..." which should read -"...damage and edging..."- to make the claim formal. Applicants greatly appreciate the Examiners kind attention to detail and accordingly have amended claim 28 by deleting the comma and inserting the connecting word "and" in the place thereof following the word "damage" thus constituting a proper Markush group. Applicants believe that this amendment to claim 28 removes any informalities from the claim thus putting claim 28 in condition for allowance. Therefore, Applicants respectfully request reconsideration and allowance of claim 28.

The Official Action rejects claims 1 - 3, 8 - 10 and 15 - 28 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, claims 1 and 20 recite "a like portion" in lines 6 and 7. The Examiner states that Applicants have not particularly pointed out what "a like portion" refers to in the claim, thus rendering the scope unclear. Applicants have amended claims 1 and 20 by deleting the word "like" thus removing the basis for the rejection. Applicants believe that this amendment to claims 1 and 20 put these claims into condition for allowance and therefore respectfully request reconsideration and allowance of claims 1 and 20.

Claims 9 and 10 are likewise rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claims 9 and 10 are deemed to be unclear as they pend from claim 1, a method of making a foil, while claims 9 & 10 are directed to a method of applying a foil to a substrate to be decorated. Applicants greatly appreciate the Examiner's attention to the details of the specification and therefore have canceled claims 9 and 10 to retain the scope of the application as a method of making a wrapping foil derived

from a previously manufactured wrapping foil. As Applicants have canceled claims 9 and 10 in this application, Applicants believe that the rejection of claims 9 and 10 based upon 35 U.S.C. 112, second paragraph, has been overcome and respectfully request reconsideration and allowance of the claims remaining in the application.

The Official Action rejects claims 1 - 3, 9 and 10 under 35 U.S.C. 103(a) as being unpatentable over Paskersky, U. S. Patent 4,084,032 in view of Matthews, et al., U. S. Published Application 2002/0097447 and Takiguchi, U. S. Patent 6,459,681. Applicants have amended claim 1 to remove informalities and to render the claim and its dependent claims definite and therefore believe that these claims are in condition for allowance, however, Applicants have further canceled claims 9 and 10 and amended claim 1 to distinguish claim 1 of this application from any and all prior art references. Specifically, Applicants have amended claim 1 to include the recitation that the image is derived from a decorative molding substrate previously wrapped with a decorative molding wrapping foil, wherein the previously wrapped substrate is substantially equivalent to the substrate to be decorated, a feature clearly not found in Paskersky, the primary reference used in the rejection, in any other prior art reference nor in the combination of Paskersky, Matthews, et al., and Takiguchi, et al., as hereinafter fully set forth. As recited in the prior art statement in the original specification on page 3, lines 22 - 25, Paskersky **only** teaches adding a texture coat to the adhesive layer of a conventional transfer foil which deflects the multiple print coats above the adhesive layer giving an effect of an embossed foil only after wrapping the foil of Paskersky upon a substrate. Prior to wrapping a substrate, the foil of Paskersky has no distinguishing contour features. The texture coat is a thermoplastic material laid down with an embossing roller and is several times thicker than the total thickness of the remaining coats already printed upon the conventional foil. The Examiner's attention is drawn to the Summary of Paskersky, specifically in lines 30 - 35 wherein Paskersky states that "...the hot stamping tape is provided with a coating or coatings in the form of a design but of such a magnitude (up to 1.5 mils) that one can actually feel the 'bumps' when the hot stamping foil of this invention is transferred to the surface to be decorated. The bumps make the surface truly three dimensional, not only appearing to be so because of a gloss

difference between the 'hills' and 'valleys.' One can actually feel the textured surface as well as see it." Paskersky thus teaches creating the "bumps" upon a conventional hot stamping foil and therefore does not teach duplicating an image **derived** from a previously decorated molding substrate. In fact, once applied to a substrate, Paskersky teaches one of the multitude of surface features Applicants might use to derive a new image of the wrapped foil to be stored as a digital image in a portable image format, importing the new digital image into an electronic graphics reader, duplicating the new image thereby creating a duplicate of the new image, overlaying a portion of the duplicated new image over the new image in one transition zone thereof thereby creating an overlapped repeating image, importing the overlapped repeating image into a printing process, printing the overlapped repeating image upon a wrapping foil and wrapping the wrapping foil upon a roll for use in foil wrapping of a substrate for use as picture frame element or building trim piece.

Furthermore, Paskersky does not teach creating the hot stamping foil but admits that the hot stamping foil used in his invention is a conventional hot stamping foil well known in the art. The Examiner's attention is drawn to lines 20 - 23 in column 3 of Paskersky wherein Paskersky incorporates U. S. Patent 3,452,861 into his disclosure. Further in that column, specifically at line 31 - 43, Paskersky describes his addition to the conventional hot stamping foil, the texture coat H, which has a thickness of 4.5 times the total thickness of all the applied foil inks of the conventional hot stamping foil of U. S. 3,452,861 to create the "bumps". Applicants have admitted the use of typical foil prints in the prior art statement not only by admitting the existence of Paskersky but also admitting that Applicants wrap substrate with decorative foils created by the process described in U. S. Patent 3,452,861 and others without specific references thereto. Applicants now bring to the art a method of creating a wrapping foil **having features derived** from a previously decorated substrate wherein an image of the previously decorated substrate becomes the basis for a new wrapping foil. Hence, the image carries with it the features of the previously decorated substrate thus constituting a substantially identical image of the previously decorated substrate. Applicants then duplicate the image having features derived from the previously decorated substrate at least once and overlay a portion of the image

derived from the previously decorated substrate successively over at least one other duplicated image of the previously decorated substrate to create an elongated repeating image of the image of the previously decorated substrate for importation into a printing process. A new wrapping foil having features of the previously decorated substrate is then created for use in a subsequent wrapping process. Paskersky adds only a texturing coat to conventional hot stamping foils and does not in any way suggest deriving a design from a previously decorated substrate, duplicating the identical design and overlaying successive duplicates into an elongated image for importation into a printing process. In lines 51 - 55 cited by the Examiner, Paskersky only describes previously known conventional patterns printed by a printing process using conventional inks and merely adds to this foil a thermoplastic layer to form contours on any substrate. Applicants, on the other hand, derive the features from a previously wrapped substrate and to suggest that the previously known patterns used by Paskersky include an image of a previously manufactured decorative molding would be reading into Paskersky the teachings of Applicants.

Matthews, et al., is drawn only to a method of repeating an image a selected number of reproductions having **different dimensions** upon a single copying sheet, each image of necessity then being either reduced or expanded in size in order to fit upon the single copying sheet. The Examiner's attention is drawn to claim 1, Figures 4 and 5 and the flow chart in Figure 6a wherein it is made clear by Matthews, et al., that the replications are of different size in order to be fitted upon a single copy sheet. Therefore, the images taught by Matthews, et al., are not identical, because they are not the same size, nor are the images **derived** from a previously decorated wrapping foil whereas Applicants teach that the image derived from the previously decorated substrate and its duplicates are, of necessity, identical in order that the features carried from the previously decorated substrate to the newly created wrapping foil will substantially conform to the features of the substrate to be decorated. Furthermore, Matthews, et al., do not teach overlaying a portion of any one image over any other portion of any other image nor do Matthews, et al., teach any portion of the image as a transition zone. Only Applicants teach creating an image of a previously manufactured decorative molding, duplicating that identical image, overlaying one of the

duplicates over the image and repeating the process in successive steps to create a length of images necessary for a printing process. Matthews, et al., actually teach away from Applicants' specification by either reducing or expanding the image to fit upon a single copying sheet and to suggest that Matthews, et al., overlays images in a repeating fashion would be reading into Matthews, et al., the teachings of Applicants. Therefore, Paskersky in view of Matthews, et al., would teach a single printed sheet having reduced or enlarged images and a thermoplastic layer on the images to force the images out of the plane of the sheet when wrapped upon a substrate teachings obviously significantly different from those included in Applicants' disclosure wherein an image of a previously manufactured decorative molding is stored as a digital image, the image is duplicated at least once thus creating an identical image, overlaying one of the duplicates over the image and repeating the process in successive steps to create a length of images necessary for a printing process.

Takiguchi, et al., describe methods of partially overlapping and joining together **disparate** partial images of one object into a single **panoramic** image and do not teach joining together duplicates of an identical image **derived** from a previously decorated substrate into a length of images for a printing process. The Examiner's attention is drawn specifically to column 1 lines 7 - 10 wherein Takiguchi, et al., state that "(T)he invention relates to an image synthesization method for synthesizing a plurality of images, in which the image areas partially overlap each other, in order to create a single synthetic image" and in column 18 at lines 7 and 8 wherein Takiguchi, et al., state that "(W)hen there is no panoramic image group, the processing is terminated." These specific limitations appear throughout the entire specification. Therefore, Takiguchi, et al., teach making a panoramic image of a plurality of disparate images, not an image of a decoration **derived** from a decorative molding substrate previously wrapped with a decorative molding wrapping foil as taught by the method contained in Applicants' specification. If it were possible to apply Takiguchi, et al., to Applicants' methods, Takiguchi, et al., would terminate as stated in column 18, lines 7 & 8 thus effectively teaching away from Applicants as Applicants supply only a single digital image for duplicating and overlapping. As Paskersky teaches adding a texture coat to a previously prepared inked foil and Matthews, et al., teach duplicating a

multiplicity of different sized images onto a single sheet, Paskersky in view of Matthews, et al., would merely teach adding a texture coat to a single sheet having a plurality of different sized images thereupon, not a new image derived from a previously decorated substrate as taught by Applicants. Furthermore, the combination of Paskersky in view of Matthews, et al., and/or Takiguchi, et al., would not suggest joining together duplicates of an identical image **derived** from a previously decorated substrate, the duplicates carrying therewith the features of the previously decorated substrate but would instead teach enlarging or reducing different images to create a panoramic image and applying a thermoplastic texture coat to the images to cause the image to be forced from the plane of the sheet when applied to a substrate. Since Paskersky does not teach deriving an image from a previously prepared substrate, a combination with Matthews, et al., and/or Takiguchi, et al., would also not teach joining together duplicates of an identical image **derived** from a previously decorated substrate, the duplicates carrying therewith the features of the previously decorated substrate as Applicants have described and claimed. Likewise, Takiguchi, et al., teach joining together disparate images to form one panoramic view which if combined with Matthews, et al., would merely reduce and duplicate this panoramic view to fit upon a single sheet of paper, whilst **adding** the texturing coating of Paskersky to the single sheet of paper would still not teach **deriving** the features from a previously wrapped decorative molding substrate. It should be abundantly clear that the features of the previously wrapped decorative molding substrate, i.e. the contour of the substrate, different shadings, different colorings or different weathering effects constitute the image, not texturing coatings that are applied to a commercially available foil.

In summary, Paskersky introduced a method of raising a surface of a wrapping foil when wrapped upon a substrate by adding a thermoplastic layer to the foil inks. Matthews describes a method of repeating an image on a single sheet of paper by reducing or expanding a first image to conform to the number of replications desired. Takiguchi, et al., teach a method of creating a panoramic image from a set of disparate images by matching key points of the overlapping images and Applicants teach a method of making a decorative molding wrapping foil comprises the steps of creating an image of a decoration

having features specific to a substrate to be decorated wherein the image is derived from a decorative molding substrate previously wrapped with a decorative molding wrapping foil. All these process are distinct from each other and separately patentable. Thus, Applicants believe that the amendments to the claims as presented above and the distinct differences between the cited references and Applicants' invention noted above distinguish over the references alone or in combination and thus Applicants have overcome the rejections advanced in the Office Action. In view of the description of the teachings of Applicants, cancellation of claims 9 and 10 and amendments to the claim 1, Applicants respectfully request reconsideration and allowance of claims 1 and 3 and claims 15 - 19 and 8 dependent thereupon respectively.

The Official Action rejects claims 8 and 15 - 28 under 35 U.S.C. 103(a) as being unpatentable over Paskersky, U. S. Patent 4,084,032 in view of Matthews, et al., U. S. Published Application 2002/0097447 and Takiguchi, U. S. Patent 6,459,681 as applied to claims 1 - 3, 9 and 10 and further in view of Applicants' Admitted Prior Art (AAPA). As explained above in the remarks regarding claim 1, Paskersky, Matthews, et al., and Takiguchi, et al., are distinct from each other and from Applicants' disclosure and therefore combinations of the reference patents do not teach Applicants' methods. Specifically, Paskersky teaches a method of making a foil having a thermoplastic forming substance placed upon a conventional foil to cause the foil, when wrapped upon a substrate, to form "bumps" that can be felt. Thus, the foil produced by the method of Paskersky would be a conventional foil with a plurality of "bumps" on the surface to be placed against the substrate. A foil produced by the method of Paskersky in view of Matthews, et al., would be an image of a different size from the original on a single sheet with a texturing layer applied to the single sheet to force the sheet out of plane when applied to a substrate. Paskersky, in view of Matthews, et al., and Takiguchi, et al., would be a single sheet having a plurality of reduced or enlarged disparate images joined together into a panoramic view printed upon a single sheet, the sheet having a texturing layer applied thereto to force the sheet out of plane when applied to a substrate. Importing such a combination into a printing process would return a plurality of single sheets, none of which could be aligned to

a substrate to be decorated as no features similar to the features of the substrate to be decorated ever were present nor could the plurality of single sheets be aligned with each other as the aligning points taught by Takiguchi, et al., would be obliterated by the texturing layer of Paskersky. Therefore, the combination of Paskersky, in view of Matthews, et al., and Takiguchi, et al., could not be used in any printing process to create a wrapping foil and therefore a combination with Applicants' Admitted Prior Art is also not possible. However, Applicants are entitled to further restriction of the independent claims under the statutes and therefore the newly created image having features derived from a decorative molding substrate previously wrapped with a decorative molding wrapping foil wherein the previously wrapped substrate is substantially equivalent to the substrate to be decorated is claimed as being introduced into an electrostatic graphic printer, these restrictions contained in claims 8 and 15 - 19. Therefore, Applicants believe that claims 8 and 15 - 19 are fully allowable under the statutes and further believe that the rejection of claims 8 and 15 - 19 has been overcome. Applicants respectfully request reconsideration and allowance of claims 1, 3, 8 and 15 - 19.

The Official Action states that claim 20 and its dependent claims 21 - 28 are product by process claims and an art rejection merely needs to meet the structural limitations of the product without regard to the process steps. Applicants have shown above that the art rejection of Paskersky, in view of Matthews, et al., and/or Takiguchi, et al., would not return a product having features of the substrate to be decorated as Matthews, et al., must be either reduced or enlarged to fit upon the sheet and Takiguchi, et al., must use a plurality of disparate images joined in a panoramic view and a combination with Paskersky would merely add a texture coating to the ink surface. The features of a substrate are not known in these combinations, nor are features of the substrate implied and cannot exist as the images of either Matthews, et al., or Takiguchi, et al., are different from the original image. Therefore, Applicants product is also not taught by the combinations advanced in the Official Action and Applicants respectfully request reconsideration and allowance of claims 20 - 28.



Applicant is greatly appreciative of the art made of record and not relied upon as kindly provided by the Examiner.

Applicants have amended claim 28 to overcome the objections raised by the Examiner, amended claims 1 and 15 - 20, to overcome the rejections under 35 U.S.C. 112, second paragraph, amended claim 1, canceled claims 9 and 10 and distinctly pointed out the differences between Applicants' invention and the cited prior art references to overcome the Examiner's rejection of 1 - 3, 9 and 10 under 35 U.S.C. 103(a), amended claim 20 and distinctly pointed out the differences between Applicants' invention and the cited prior art references to overcome the rejection of 20 - 28 under 35 U.S.C. 103(a) thereby placing this application in condition for allowance. Thus, claims 1 - 3, 8 and 15 - 28 remain in this application and Applicants respectfully request allowance thereof.

In view of the above, an Action on the merits of this application, as amended, and an allowance thereof is respectfully requested.

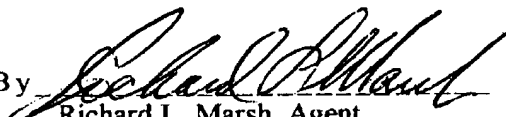
Respectfully submitted,

Herbert M. Straub and

Marty D. Straub, Joint Inventors

Date: 26 April 2004  
Phone: (417) 887-8441  
(417) 887-3731 (home)  
Fax: (417) 887-8441

By

  
Richard L. Marsh, Agent  
Registration No. 31,637  
4116 E. Latoka  
Springfield, Missouri 65809